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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,760	01/04/2002	Anthony A. Sauve	96700/725	6299

7590 03/11/2003

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EXAMINER	
FISHER, LATONIA M	6

ART UNIT	PAPER NUMBER
1623	

DATE MAILED: 03/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/038,760	SAUVE ET AL.	
	Examiner	Art Unit	
	La Tonia M. Fisher	1623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-29 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) 1-29 are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claims 1-29 are pending.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-21, drawn to deoxyriboside compounds and compositions comprising said deoxyriboside compounds classified in class 514, subclass 43.

II. Claims 22-25, drawn to methods for inhibiting an ADP-ribosyl transferase, ADP-ribosyl cyclase, or ADP-ribosyl hydrolase enzyme comprising contacting the enzyme with a deoxyriboside compound, classified in class 435, subclasses 195, 199, and 232.

III. Claims 26-29, drawn to methods for treating a disease or condition associated with ADP-ribosyl transferase, ADP-ribosyl cyclase or ADP-ribosyl hydrolase enzyme in a subject comprising administering a deoxyriboside compound to the subject, classified in class 514, subclass 903.

Inventions I and II are related as product and process of use. Likewise, Inventions I and III are related as product and process of use The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product of invention I may be used in materially different methods as evidence by applicant using the product in the distinct methods of Inventions II and III.

Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case Inventions II and III possess different functions. While the function of Invention II is to inhibit an ADP-ribosyl transferase, ADP-ribosyl cyclase, or ADP-ribosyl hydrolase enzymes, the function of Invention II is not limited to treatment of diseases as is the function of Invention III. Additionally, the inventions produce different effects. Inhibiting an ADP-ribosyl transferase, ADP-ribosyl cyclase, or ADP-ribosyl hydrolase enzyme produces a different effect than preventing or treating a disease.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, recognized divergent subject matter and/or the search required for Invention I or II is not required for Invention III and vice versa, and a search for the three unrelated methods would indeed impose an undue burden upon the examiner in charge of this application restriction for examination purposes as indicated is proper. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). Applicant is entitled to one method of use per application. Applicant is entitled to one composition of matter and one method for using same. A method will be examined insofar as it relates to the elected composition of matter.

Please note that, if Group II is elected for prosecution, Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, Group II

contains methods for inhibiting an ADP-ribosyl transferase, ADP-ribosyl cyclase or ADP-ribosyl hydrolase enzyme. Transferases catalyze the transfer of a group of atoms form one molecule to another. Hydrolases catalyze hyrolysis reactions. Lyases catalyze the formation of double bonds by removing chemical groups from a substrate without hydrolysis or catalyze the addition of chemical groups to double bonds. Thus, the methods of inhibiting an ADP-ribosyl transferase, ADP-ribosyl cyclase or ADP-ribosyl hydrolase enzyme would involve steps that may or may not be similar or related to one another.

If Group III is elected for prosecution, Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, Group III contains methods of treating diseases and conditions associated with an ADP-ribosyl transferase, ADP-ribosyl cyclase or ADP-ribosyl hydrolase enzyme. Diseases associated with these enzymes such as angina, tropical spastic paraparesis and progressive multifocal leukoencephalopathy are not necessarily linked or related. The applicant must select a singular disease/condition for treatment.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after

the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to La Tonia M. Fisher whose telephone number is (703) 306-5819. The examiner can normally be reached on Monday - Friday from 9:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on (703) 308-4624. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

LMF
March 10, 2003

JAMES O. WILSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600